

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Docket № 14829US02)

In the Matter of:)	
Jeyhan Karaoguz, et al.)	
)	Electronically filed on 03-MAR-2009
Serial No. 10/672,907)	
)	
Filed: September 26, 2003)	
)	
For: THEFT PREVENTION OF MEDIA)	
PERIPHERALS IN A MEDIA)	
EXCHANGE NETWORK)	
)	
Examiner: Christopher A. Revak)	
)	
Group Art Unit: 2431)	
)	
Confirmation No. 9187)	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Applicant requests review of the final rejection in the above-identified application, stated in the final Office Action mailed on December 3, 2008 (hereinafter, the Final Office Action) with a period of reply through March 3, 2009. The Applicant also requests review of the arguments stated on page 2 of the Advisory Office Action mailed on February 25, 2009 (hereinafter, the Advisory Office Action). No amendments are being filed with this request.

This request is being filed with a Notice of Appeal. The review is being requested for the reasons stated on the attached sheets.

REMARKS

The present application includes pending claims 1-25. In particular, claims 1-4 and 7-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,643,781 (“Merriam”) in view of U.S. 7,133,920 (“Tsujisawa”) and U.S. 7,317,798 (“Saito”). Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view of Tsujisawa, Saito and U.S. 5,748,084 (“Ishikoff”). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following:

I. Rejection of Claim 1

The Applicants now turn to the rejections, in particular. Claim 1, for example, recites, in part, “wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered.” The claim clearly recites that the device serial number is associated **with a location where the communication device is registered**.

As noted above, Merriam, Tsujisawa and Saito form the basis for all claim rejections. The Final Office Action acknowledges that the “combined teachings of Merriam and Tsujisawa fail to disclose of registration information associated with a device serial ID number associated where the location [of] the communication device is registered.” See December 3, 2008 Final Office Action at page 3. In order to overcome this deficiency, the Final Office Action cites Saito at column 14, lines 49-67.

Saito, at column 14, lines 49-67, discloses that the “device ID of the mobile terminal corresponding to the acquired home address is registered in the database 114.” See Saito at column 14, lines 52-54. **While Saito discloses that the device ID is registered in the database, there is nothing in the portion of Saito relied on by the Examiner, nor the remainder of Saito, that describes, teaches or suggests that the device ID is associated with a location where the mobile terminal itself is registered. Again, Saito merely discloses that the device ID is registered in a database.**

In the Advisory Office Action, the Examiner again refers to col. 14, lines 49-53 of Saito and states the following: “Saito discloses of acquiring a home address as an IP address of a corresponding terminal and it is checked to see whether the

acquired home address is registered in the database.” The Applicant disagrees. The IP address of the responding terminal 102 is acquired from the DNS server. Saito then acquires the device ID plus a locator information of the device ID from the database 114(i.e., a database record locator for the device ID entry). The IPv6 address is then generated (based on the database record locator information and the obtained IP address) and transmitted to the calling terminal 101. The fact remains that the database 114 only includes device IDs (with each record also having a database record locator information), but without associating the device ID with an actual physical location of where the mobile terminal itself is registered.

None of Saito, Merriam or Tsujisawa describes, teaches or suggests, however, “wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered,” as recited in claim 1. Independent claims 7, 9 and 15 recite similar limitations. Thus, for at least these reasons, the Applicants respectfully submit that the proposed combination of Merriam, Tsujisawa and Saito do not render claims 1-4 and 7-25 unpatentable.

Additionally, claim 22 recites “wherein said registering comprises entering the device serial ID number of the communication device associated with said location where the communication device is registered if the device is to be used only at said location where the communication device is registered, and wherein said registering comprises entering the device serial ID number of the communication device, a user name and a password if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.” Claims 23-25 recite similar limitations. The Final Office Action relies on Saito at column 14, lines 49-67 as disclosing the limitations regarding the device ID. See December 3, 2008 Final Office Action at page 10. However, Saito merely discloses that a device ID is registered in a database. There is nothing in the cited references, however, that describes, teaches or suggests “**entering the device serial ID number of the communication device associated with said location **where the communication device is registered** if the device is to be used **only at said location where the communication device is registered**, and wherein said registering comprises**

entering the device serial ID number of the communication device, a user name and a password if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.” Indeed, there is nothing in the portion of Saito relied on by the Final Office Action (nor the remainder of Saito) that describes, teaches or suggests entering a device serial ID number of a communication device in order to use the communication device. Thus, for at least these additional reasons, the proposed combination of references does not render claims 22-25 unpatentable.

The Applicants also respectfully submit that the proposed combination of Merriam, Tsujisawa, Saito and Ishikoff does not render claims 5 and 6 unpatentable for at least the reasons discussed above.

II. Inherency

The Advisory Office Action states the following in page 2:

it is inherent that the device 10 is entered since it is being used for comparison to determine if it is registered at a particular location;

Initially, regardless of whether this statement is true or not, the Applicant notes that it appears that claim 1 is being rejected based on inherency.

The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See *id. citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicant respectfully submits that neither Saito itself nor the Final Office Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” Saito.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Applicant respectfully submits that the Final Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 1 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a “basis in fact and/or technical reasoning.” Accordingly, the Applicant respectfully submits that, absent a “basis in fact and/or technical reasoning” for the rejection of record, that rejection should be reconsidered and withdrawn.

III. Conclusion

The Applicant respectfully submits that claims 1-25 of the present application should be in condition for allowance at least for the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: 03-MAR-2009

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